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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,420	03/11/1999	ALFRED ALASIA	1455.028	7018

7590 02/22/2005

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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/267,420

Applicant(s)

ALASIA, ALFRED

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-5,8,9,46 and 49-60 is/are pending in the application.
- 4a) Of the above claim(s) 55-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5,8,9,46 and 49-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 2, 6, 7, 10-45 and 47 and 48 have been canceled. Claims 49-60 have been added.

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***Election/Restriction***

2. Newly submitted claims 55-60 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 55-60 is directed to a method of producing a self authenticating article, wherein the particulars of the method (digitally encoding) is not recited in the product claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 55-60 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-5, 8, 9, and 46, 49-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al (WO 98/15418) in view of Drinkwater et al (WO-9427254).

Taylor et al disclose in Fig. 1-4, a self-authenticating article comprising: a plastic paper substitute (2) which can be in the form of a banknote or travelers checks, or the like having indicia (4) printed on the plastic paper substitute; authenticating means is a decoding lens for revealing encoded hidden indicia (Page 15, lines 7-19) wherein the authenticating area (5) is positionable in juxtaposed relation to the hidden indicia thereby providing instant verification of the authenticity of the article (page 15, lines 17-19) and wherein the decoding lens can be an inlaid preformed lenticular lens.

However, Taylor et al does not disclose wherein lens has a lens frequency corresponding to the predetermined line frequency of the encoded hidden image, wherein the lens is positioned to overlie the printable surface so that encoded, hidden indicia may be viewed; and wherein the plastic paper substitute is selected from the group consisting of synthetic resin films having a high

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degree of writability and printability, laminate composite structures including combinations of paper and non-paper materials, latex saturated durable papers, coated polyolefin substrates formed from randomly dispersed and bonded polyolefin filaments, reinforced papers, and combinations thereof.

Drinkwater et al discloses in Fig. 1A-1E, wherein a lenticular lens (3, as stated on Page 7, lines 24-33) has preformed lenticules arrays (Page 22, lines 22-28) which are registered in the same relationship (pitch or frequency) to the scrambled image (2), wherein the image can be reconstructed, or decoded (Page 22, lines 30-36, and page 5, lines 5-22).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Taylor et al's article with a lenticular lens having a frequency corresponding with the images frequency to decode the image as taught by Drinkwater et al as an alternative means of authenticating an article and decoding indicia.

In regards to **Claims 5, 49 and 52**, wherein the hidden image is formed from a plurality of lines printed with a line frequency that is multiple of the lens frequency; and wherein the lenticular lens is produced by an intaglio engraving process, the patentability of a product does not depend on its method of production. If the product in the product-by process claims is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Therefore, the lens and hidden images can be produced or formed by any desired process.

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In regards to **Claims 8 and 53**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the article in any desired material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Therefore, it would have been obvious to construct the plastic paper substitute with any desired components, since applicant has not disclosed the criticality of using particular material components, and invention would function equally as well with any component material.

***Prior Art References.***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Drinkwater et al, Drinkwater et al ('700), Drinkwater et al ('147), Thomas et al, Heninger et al, Matos, Gottfried et al, Mowry et al, Hackwood et al, Rosenthal, and Anderson disclose similar authenticating articles.

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***Response to Arguments***

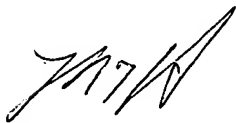
4. Applicant's arguments with respect to claims 3-5, 8, 9 and 46 have been considered but are moot in view of the new ground(s) of rejection. In response to applicant's argument that Taylor could not be combined with Drinkwater et al, since Taylor only deals with the magnification of the image and Drinkwater et al does not, the examiner submits that Drinkwater is now used to disclose a lenticular lens in register having frequency (pitch) that correspond to the hidden indicied image on a substrate in order to decode the image, wherein there is magnification by the decoding lens.



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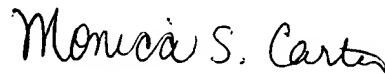
**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Derris Banks, can be reached on (571) 272-4419. The fax number for TC 3700 is (703)-872-9306.



MTH

February 16, 2005

  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**